

said side portions depending from said interconnecting portion and defining a space between them, below the interconnecting portion, and forming the side portions of the letter "M";

10 said side portions of the foam body including confronting, temple engaging, inside surfaces, spaced apart a distances less than a temple-to-temple width of a person's head;

15 said foam body being constructed from a springable foam that stores spring energy when bent and allows the side portions to be sprung apart, and when released move back towards each other,

whereby the side portions of the foam body are adapted to be sprung apart so as to enable a person to place his/her head between the side portions, and the side portions can be released so that they will spring back towards their static positions and clamp onto the person's head, so as to secure the letter "M" display onto the person's  
20 head.

#### REMARKS

Claim 1 has been amended for the purpose of overcoming the rejection under 35 U.S.C. § 112, second paragraph. Specifically, the expression "a foam body having the shape of a letter 'M'" has been changed to read – a foam body in the shape of a letter 'M' –. In claim 1, line 10, "parts" has been changed to – portions –.

In claim 1, line 14, "the" has been changed to – a –.

In claim 1, line 18, "can be" has been changed to – are adapted to be –.

It is submitted that claim 1 and claims 2-10 that depend either directly or indirectly from claim now comply with 35 U.S.C. § 112, second paragraph. The lack of antecedent basis has been corrected. The expression "temple-to-temple width of a person's head", this language is very easy to understand and is definite. It is true that "a

child's width is smaller than an adult's width". However, this only means that the displays made to be worn by a child will be made to have a width to fit a child whereas the displays made to be worn by an adult will need to be sized to fit the adult. Claim 1 does not require that the temple-to-temple width must fit every head. If the temple-to-temple width fits a single person's head, the terms of the claim are met.

The Examiner is asked to reconsider and withdraw the rejection of claims 1-10 based on U.S. Patent No. 3,440,750 granted April 29, 1969 to Joseph Toth and George Lobas (herein after "Toth et al. 3,440,750") and U.S. Patent No. 1,245,475, granted November 6, 1917 to Irene L. Lindheim (herein after "Lindheim 1,245,475").

The invention of Toth et al. 3,440,750 relates to the use of static electricity for connecting a substantially rigid plastic foam body to a board 12. One disclosed example of the rigid plastic foam body is cut or molded into the shape of the letter "A", as shown by Fig. 3 of the patent drawing. The patentees' mention that the foam bodies may employ "a variety of different shapes," but there is no specific disclosure of making a body in the form of the letter "M." The key feature of the foam bodies is that they be constructed from a foam plastic that creates static electricity when rubbed so that the static electricity will connect them to the board 12. There is no other use for the body 24 specified in the patent and the size of the "A" body 24 is not specified in the patent. Most clearly, the patent does not disclose mounting a letter "M" or any other letter on a person's head to serve as a head worn display.

Lindheim 1,245,475, like Toth et al. 3,440,750 also relates to providing objects that are constructed to be secured to a board 1. The disclosed members are thin and are in the shape of letters and they include the letter "M". A recess 3, in shape of the letter "M", is formed in the board 1. The member 2 in the form of the letter "M" is sized to be set into the recess 3. The size of the letter "M" is not disclosed in this patent and

the material from which the letter "M" is made is also not disclosed. "Cardboard" is given as a suitable material for the board 1 and so it can be assumed that cardboard may also be used for the letter "M". Very clearly, there is no disclosure in this patent of constructing the letter "M" of sufficient size and from a suitable foam material so that it can be mounted on a person's head to serve as a head-mounted display.

It is submitted that Toth et al. 3,440,750 and Lindheim 1,245,475 are both non-analogous art and should not be considered to be proper references for that reason. In *re Oetiker*, 977 Fed. 2d. 1443, 24 USPQ 2d. 1443 (Fed. Cir. 1972), the court stated:

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Deminski*, 796 Fed. 2d 436, 442 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the Examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In Re Wood*, 599 F2d. 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) – In other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

Here, the problem confronted by the inventor was how to construct a member in the shape of a letter "M" so that it can be attached to the head of a person to be worn by him/her and displayed to others who are either in front or behind the person.

In *Oetiker*, the court further stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

Here, a person having no knowledge of applicant's invention would have no reason to consult Toth et al. 3,440,750 and/or Lindheim 1,245,475. Applicant's device is worn on a person's head whereas Toth et al. 3,440,750 and Lindheim 1,245,475 both relate to ways of securing an object to a mounting board. The only relevance of these patents is that Toth et al. 3,440,750 discloses a letter "A" constructed from foam and Lindheim 1,245,475 discloses a number of letters constructed from an unspecified material wherein one of the letters is the letter "M". Without having knowledge of applicant's invention, the Examiner would have no reason to look for either one of these references. Neither Toth et al. 3,440,750 nor Lindheim 1,245,475 is concerned with the particular problem with which the applicant was concerned. Toth et al. 3,440,750 is concerned with securing objects to a mounting board 12. It so happens that one of the members is in the form of a letter "A". Lindheim 1,245,475 is also concerned with connecting members to a mounting board 1. Toth et al. 3,440,750 decided on using static electricity for securing the articles 14 to the board 12. Lindheim 1,245,475 decided to provide his board 1 with recesses that are sized and shaped to receive the article 2. Applicant's problem is to provide a letter "M" that is capable of being secured to a person's head to be worn by that person for display to other people both in front and behind the person. The Examiner has not shown any reason why a person of ordinary skill, seeking to solve the problem of securing an object in the shape of a letter "M" to a person's head, would reasonably be expected or motivated to look to the art field which includes Toth et al. 3,440,750 and Lindheim 1,245,475. In addition, these references, whether viewed separately or in combination, would not lead another to applicant's invention.

Another case to consider is *Ruiz v. A.B.C. Chance Co.*, 234 F3d 654, 57 USPQ 2d. 1611, (Fed. Cir. 2000). In this case, the Federal Circuit stated:

The district court erred in failing to make clear and particular findings as to why the Gregory patents and the Fuller and Ruipier method are within the appropriate scope of the prior art in determining the obviousness of the '368 and '107 patents. The scope for the prior art includes art that is "reasonably pertinent to the particular problem with which the invention was involved." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F2d. 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). In order to prevent a hindsight-based obviousness analysis, we have clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.

Here, the Examiner states that "Toth et al. 3,440,750 teaches" characters constructed of foam plastic such [as] polyethylene foam cut or molded into various desired shapes such as the letter "A" [24]." The Examiner acknowledges that Toth et al. 3,440,750 "does not teach the foam letter 'M'." However, the Examiner points out that Lindheim 1,245,475 "teaches a plurality of characters 2 in the shape in letters of the alphabet." The Examiner states, "[s]pecifically Lindheim teaches the letter 'M' having a 'V' shaped central portion and side legs extending down from the upper distal end of the central portion, whereby the [legs] extend below the lower portion of the 'V'". The Examiner then concludes by stating, "[i]t would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the character of the device taught by Toth in the shape 'M' taught by Lindheim to provide a means of displaying the letter 'M' on the board."

It is now well settled, claims cannot be declared unpatentable merely upon finding similar elements in separate prior art patents. In *Ruiz* the court stated that "this cannot be the law under the statute, § 103." The court then quoted from *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F3d 953, 957, 43 USPQ 2d 1294, 1297 (Fed. Cir. 1997) in which the court stated:

It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.

As stated above, in his rejection, the Examiner here stated that it would have been obvious "to construct the character of the device taught by Toth in the shape 'M' taught by Lindheim to provide a means of displaying the letter 'M' on the board." This last functional statement, "displaying the letter 'M' on the board", disregards significant limitations in the claims. Quite clearly, applicant is not concerned with displaying the letter "M" on a board.

Claim 1 commences with the preamble:

A letter "M" display, mountable on a person's head, comprising:

This preamble is a limitation to the claim. In *Corning Glassworks v. Sumitomo Electric*, 866 F.2d 1251, 9 USPQ 2d 1962 (Fed. Cir. 1989) the Federal Circuit stated:

The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventor has actually invented and intended to encompass by the claim. Here, the '915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system, not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorce from reality. The invention is restricted to those fibers that work as wave guides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure. See *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Rather, those words do give "life and meaning" and provide further positive limitations to the invention claimed. See *Locktite*, 781 F.2d at 866, 228 USPQ at 92. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), *cert. denied*, 469 US 857 (225 USPQ 792)(1984).

Here the preamble makes clear that the claimed letter "M" is "mountable on a person's head." On page 1 of the specification, lines 15-22, it is stated:

It is an object of the present invention to provide a display that is adapted to be mounted onto the head of a fan and which is provided with the shape of a

letter "M" that has some association with the particular team. For example, the Seattle Mariners baseball team is commonly referred to as the "M's". It is an object of the invention to provide a display in the shape of a "M" that is adapted to be self-secured to the head of a fan, so that, for example, the fan can wear it to a game or elsewhere.

Quite clearly, there is no place in the application where it is stated that applicant is concerned with adapting a letter or other object so it can be secured to a mounting board, the objective of Toth et al. 3,440,750 and Lindheim 1,245,475. Applicant's object is to provide "a display in the shape of a 'M' that is adapted to be self-secured to the head of a fan, so that, for example, the fan can wear it to a game or elsewhere." This description makes the preamble language "mountable on a person's head" a part of the claimed invention that cannot be disregarded when considering obviousness.

Other key limitations in claim 1 are:

- said side portions of the foam body including confronting, temple engaging, inside surfaces, spaced apart a distance less than the temple-to-temple width of a person's head;

- said foam body being constructed from a springable foam that stores spring energy when bent and allows the side portions to be sprung apart, and when released move back towards each other,

- whereby the side portions of the foam body are adapted to be sprung apart so as to enable a person to place his/her head between the side portions, and the side portions can be released so that they will spring back towards their static positions and clamp onto the person's head, so as to secure the letter 'M' display onto the person's head.

In making his rejection, the Examiner has totally disregarded these claim limitations. This is legal error. In *re* Echerd and Watters, 471 F2d 632, 176 USPQ 321 (CCPA 1973), the court approved the use of the claim language:

- having sufficient flexibility and wet strength to permit the same to be wrapped when wet around insulated pipe surfaces and the like, and in having sufficient adhesive characteristics to firmly bond itself to such surfaces upon subsequent drying, --

- having substantial flexibility in both wet and dry states,

- having adhesive characteristics, when wet, to adhere the pipe lighting material to a surface around which it is wound, and when subsequently dried, to firmly bond and form with said fabric base and adherent, non-dusting covering on said surface.

In its decision, the court stated:

There is nothing intrinsically wrong in defining something by what it does rather than by what it is. In re Swinehart, 58 CCPA 1027, 1030, 439 F2d 210, 212, 169 USPQ, 226, 228 (1971); In re Fuetterer, 50 CCPA 1453, 319 F2d 259, 138 USPQ 2117 (1963). Here, the flexibility, wet strength and latent adhesive requirements were cited in the claims must be recognized as positive qualities of appellant's product. While the Patent Office may properly require proof that the functional limitations being relied upon are not inherent characteristics of the prior art, Swinehart, 58 CCPA at 1031, 439 F2d at 213, 169 USPQ at 229, these potentially distinguishing features cannot simply be ignored.

It is applicant's position that the above quoted limitations from claim 1 cannot be ignored in this case. These limitations are neither disclosed by nor obvious from Toth et al. 3,440,750 and/or Lindheim 1,245,475.

In *Fuetterer*, the court approved use of the claimed language "a sufficient amount of a vulcanizing agent to vulcanize the rubber, and a reinforcing agent in an amount sufficient to provide a tread stock having high abrasive resistance." Here, the similar language is "spaced apart a distance less than the temple-to-temple width of a person's head," "constructed from a springable foam that stores spring energy when bent and allows the side portions to be sprung apart, and when released move back towards each other" and "whereby the side portions of the foam body are adapted to be sprung apart so as to enable a person to place his/her head between the side portions, and the side portions can be released so that they will spring back towards their static positions and clamp onto the person's head, so as to secure the letter 'M' display onto the person's head."

In *Ex Party Pilkington*, 137 USPQ 229 (P.O. Bd App 1962), the Board accepted as a proper claim limitation the language "to permit said layer of molten glass to flow laterally unhindered to the limit of its free flow under the influence of gravity and surface tension." The board stated that this language served as limitations upon the chamber



wall spacing and the temperature regulators to which they refer, and constitute "a proper structural definition of the apparatus."

In *In Re Venezia*, 530 F2d 956, 189 USPQ 149 (CCPA 1976), the court approved the claim language "each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." The court stated that this language inparts a structural limitation to the sleeve. The last part of the claim under consideration contained additional language that was criticized by the Board, including "may be slideably positioned," "slideably repositioned," "when said sleeves \*\*\* are assembled," and "when said housing is in its repositioned location." In reversing the Board, the Court stated that this language also defines present structures or attributes of the thing being claimed. It stated:

Again the present structural configuration for the housing is defined in accordance with how the housing inter-relates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes that they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims.

Here, a person skilled in the art would have no difficulty determining whether or not the "side portions of the foam body were spaced apart a distance less than a temple-to-temple width of a person's head." A person skilled in the art would have no difficulty in determining whether the "sprung apart", "spring back" and "clamp onto" features were on a given display.

Claim 2 depends from claim 1 and further specifies that the foam body is constructed from "a flexible polyurethane foam". Granted, polyurethane foam is a known substance. However, claim 1 specifies that the foam is "a springable foam that stores spring energy when bent and allows the side portions to be sprung apart, and

when released move back towards each other." Thus, claim 2 claims "a flexible polyurethane foam" that is "springable" and "stores spring energy when bent and allows the side portions to be sprung apart, and when released, move back towards each other." Toth et al. 3,440,750 makes reference to "polyurethane foam" but makes no reference to the claimed characteristics of the foam because the letters, numerals and other characters to which it relates does not depend on these characteristics.

Claim 3 depends from claim 1 and specifies that "the foam body is compressable and when compressed will store spring energy, wherein there is some compression of the side portions of the foam body when the foam body is clamped onto a person's head." Toth et al. 3,440,750, the only one of the two references that makes reference to a foam body, does not disclose these characteristics of a foam body that is in the shape of the letter "M".

Claim 4 depends from claim 3 and further specifies that "the foam body is a flexible polyurethane foam." The arguments made above with respect to claims 2 and 3 both relate to claim 4.

Claim 5 depends from claim 1 and specifies that "the side portions of the foam body are squared members and the inside surfaces of the side portions are substantially planar and are parallel to each other." These features are illustrated quite clearly by the application drawing. They are not illustrated by Toth et al. 3,440,750 because this patent does not disclose a foam body in the shape of a "M". Lindheim 1,245,475 discloses an object 2 in the shape of a "M". But, it is not disclosed as being made from foam and it does not appear to have squared side portions with inside surfaces that are substantially planar. The "M" disclosed by Lindheim 1,245,475 appears to be made from a very thin material.

Claim 6 depends from claim 1 and specifies that "the foam body is provided with at least one color that is color associated with a particular sports team." This feature is not disclosed by either of the reference patents. Neither patent makes reference to a sports team.

Claim 7 depends from claim 1 and specifies that the letter "M" has a border of a first color that is associated with a particular sports team, and within the border the foam body is colored with a second color that is associated with the same team." These features are not disclosed by the reference patents. Neither of the patents makes reference to a sports team or choosing the colors of a sports team.

Claim 8 depends from claim 6 and further specifies that the "side portions of the foam body are squared members on the inside surfaces of the side portions are substantially planar and are parallel to each other." Thus, the arguments made above with respect to claim 5 apply to claim 8 as well.

Claim 9 depends from claim 7 and also specifies that "the side portions of the foam body are squared members and the inside surfaces of the side portions are substantially planar and are parallel to each other." Thus, the arguments made with claim 5 also pertain to claim 9.

Claim 10 depends from claim 9 and further specifies that "the foam body is a flexible polyurethane foam." As stated above, the addition of this feature to the claim means that the foam body is constructed from a flexible polyurethane foam that stores spring energy when bent and allows the side portions to be sprung apart, and when released move back towards each other." Quite clearly, claim 10, when considered as a "whole", is neither disclosed by nor obvious from the reference patents.

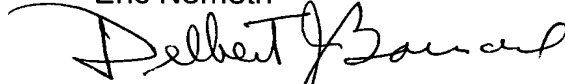
For the reasons set forth above, it is submitted that claims 1-10 are all patentable over the patents that were cited by the Examiner. It is again submitted that these

patents are not proper "prior art" because they are not concerned with the problem that has been addressed by the applicant in the making of his invention.

Early reconsideration and allowance of this application are requested.

Respectfully submitted:

Eric Nemeth

A handwritten signature in black ink, appearing to read "Delbert J. Barnard". The signature is fluid and cursive, with a long horizontal stroke extending to the left.

Delbert J. Barnard, Reg. No. 20,515  
Barnard & Pauly, P.S.  
P.O. Box 58888  
Seattle, WA 98138-1888  
(206) 246-0568  
Fax: (206) 243-4618

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

Amended claim 1 as follows:

1. (amended) A letter "M" display, mountable on a person's head, comprising:

a foam body [having] in the shape of a letter "M" and including a pair of laterally spaced apart side portions and an interconnecting portion;

5 said interconnecting portion forming a substantially "V" shaped central upper portion of the letter "M";

said side portions depending from said interconnecting portion and defining a space between them, below the interconnecting portion, and forming the side [parts] portions of the letter "M";

10 said side portions of the foam body including confronting, temple engaging, inside surfaces, spaced apart a distances less than [the] a temple-to-temple width of a person's head;

said foam body being constructed from a springable foam that stores spring energy when bent and allows the side portions to be sprung apart, and when released  
15 move back towards each other,

whereby the side portions of the foam body [can be] are adapted to be sprung apart so as to enable a person to place his/her head between the side portions, and the side portions can be released so that they will spring back towards their static positions and clamp onto the person's head, so as to secure the letter "M" display onto the  
20 person's head.